

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Perry R. CZIMMEK

Application No.: 09/813,912

Filed: March 22, 2001

For: Method of Control for a Self-Sensing Magnetostrictive Actuator



Confirmation No.: 4677

Group Art Unit: 2834

Examiner: Judson Jones

**Mail Stop Issue Fee**

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

**COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE**  
**PURSUANT TO 37 C.F.R. § 1.104 (e)**

Sir:

In response to the Statement of Reasons for Allowance in the Notice of Allowability dated October 20, 2003, the following comments are submitted.

Applicants do not believe that the Statement of Reasons for Allowance in this case is warranted/proper under 37 C.F.R. § 1.104(e) and M.P.E.P 1302.14 because the Reasons for Allowance states that the claims are allowed based on specific features recited in claim 1. Furthermore, the Reason for Allowance states that claim 1 is also allowable because there is no motivation to apply U.S. Patent No. 5,698,911 of Dunfield et al with Hasselmark. Applicant respectfully asserts that, not only is there a lack of motivation to combine Dunfield with Hasselmark (as confirmed by the Examiner), Dunfield is inappropriate to combine with Hasselmark because Dunfield shows and describes a moving coil whereas, in contrast, Hasselmark involves, in part, the feedback control of a magnetostrictive member.

While Applicant believes that the claims are allowable and patentably distinguish over the prior art, Applicants do not acquiesce that patentability resides in each feature, exactly as expressed in only claim 1, nor that each and every feature in claim 1 is required for patentability. And, Applicant submits that patentability is based on the claimed invention as a whole, as recited in claims 1, 7, 10, and 18, and not solely on one or more particular features recited in the claim 1.

Respectfully submitted,

Date: January 20, 2004

By: \_\_\_\_\_

Khoi Q. Ta

Registration No. 47,300

Morgan, Lewis & Bockius LLP  
1111 Pennsylvania Avenue, N.W.  
Washington, DC 20004

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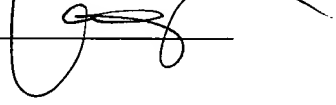
**TRANSMITTAL OF REPLACEMENT DRAWINGS**

Applicants respectfully submit a replacement drawing sheet containing four sheets of four figures pursuant to the Examiner's Approval of the Request for Approval of Drawing Revision filed December 23, 2002. Applicants respectfully assert that these changes introduce no new matter in that they conform to the specification and/or drawings as originally filed, pursuant to 37 C.F.R. § 1.81(d).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: January 20, 2004

By:   
Khoi Q. Ta  
Reg. No. 47,300

**Customer No. 009629**

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Avenue, N.W.

Washington, DC 20004

Telephone: (202) 739-3000

Facsimile: (202) 739-3001